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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,882	08/24/2001	Joachim Sacher	Sacher II-Div	1028

7590 06/09/2003

Klaus J. Bach
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EXAMINER

MOORE, KARLA A

ART UNIT	PAPER NUMBER
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1763

DATE MAILED: 06/09/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/902,882

Applicant(s)

SACHER, JOACHIM

Examiner

Karla Moore

Art Unit

1763

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05/29/03 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1A-20

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

GREGORY MILLS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

Continuation of 2. NOTE:

The presently added amendment has not been searched and would require further search and further consideration.

Applicant argues that the their personal interpretation of the claim should have been quite clear. Examiner disagrees. First of all, while Applicant's invention does include an embodiment with individual shutters for each laser, Applicant's invention also includes an embodiment which comprises a single shutter for multiple lasers as opposed to individual shutters (see Figure 6A). The claim, as it now stands, reads on either of these embodiments.

Additionally, Applicant points to the citation of the 5,980,975 patent in Applicant's response to the rejected claims as evidence of the Applicant's clear understanding of the rejection and the cited prior art used against the Applicant's claims. While the 5,980,975 patent was cited in the Application, it was not used in a rejection against the claims. In an attempt to expedite prosecution, the Examiner responded to the arguments as thoroughly as possible, with respect to the 5,980,975 patent and the patent that was actually used in the rejection.

Applicant also claims that it was only after "repeated discussion with the examiner" that the Applicant understood why the application of the prior art against the present claims was valid. Examiner points to the "Response to Arguments" section of the Office Action in Paper No. 11, where the Examiner clearly states why the art continued to be applied against the claims.

Applicant also claims that the Examiner "indicated that an amendment defining an arrangement in which an individual shutter was provided for each laser would distinguish the claimed apparatus from the cited prior art and therefore render the invention patentable over [the presently cited] prior art". While this may be true, as noted above, the invention has not yet been searched with this limitation and as noted above additional search and consideration is necessary prior to considering passing the Application to issue.

In conclusion, Applicant's interpretation of the claim is not the standard for applying prior art to the claims of a patent application, especially when an alternative interpretation is supported by the Applicant's specification, as well. It is up to the Applicant to use claim language to "clearly" describe their invention so that it distinguishes over the prior art. If Applicant was so intent on claiming a specific embodiment, the newly presented language in this second after-final amendment should have been presented earlier.